

**REMARKS**

1       The Examiner rejected claims 1 and 4 under 35 U.S.C. § 102(b) as being  
anticipated by Kater (5,046,509). Specifically, the Examiner incorrectly states that the  
Kater device is provided with a "sleeve 112 that is slidably coupled to the outer surface  
of the elongated tube" 100. Kater does not teach or otherwise disclose a sleeve or a  
5 gasket that is slidably coupled with a tube. Rather, the Kater specification, at column 3,  
lines 20-24, states that

10      the cylindrical seal 108 includes a central aperture 110 within which the  
mounting end 104 of the needle 100 is fixedly attached. Furthermore,  
the cylindrical seal 108 is fixedly attached to a needle receiving end 112  
of the first connectormember 106.

15      Clearly, the Kater device is provided with a needle or tube that is in a fixed, non-sliding  
engagement with a seal, which is in a fixed, non-sliding engagement with the sleeve.  
Applicant's device, however, clearly teaches and claims a sleeve and sealing gasket  
that are slidably engaged with the outer surface of the tube in a manner that permits  
selective, sliding movement of the sleeve and gasket along a length of the tube's outer  
surface.

20      The Examiner further argues that he is "interpreting the claimed elements 'sleeve  
that is slidably coupled' in this way: since the tube and gasket and sleeve are all  
separate elements, the gasket must inherently be 'slidably mounted' along with the  
sleeve on the tube." The Examiner then states that "according to Microsoft Bookshelf  
Dictionary the definition of *coupled* is: two things connected together. Thus, 'attached'  
can be considered synonymous as connected together." The Examiner's argument is  
unclear and fails to address the issue of the relative movement enabled by the  
25

connection between the gasket and sleeve with the tube of applicant's invention. Claim  
1 does not include a limitation that reads, in part, "sleeve that is slidably coupled." However, in an effort to clarify the matter and expedite the prosecution of this matter, claim 1 has been amended to specifically claim the structural and sliding engagement  
5 between the components of the applicant's invention. Accordingly, claim 1 is believed to be allowable, since a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal, Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

10 Claim 4 depends from claim 1 and is believed to be allowable for at least the reasons set forth hereinabove with respect to claim 1. Applicant respectfully disagrees with the Examiner's position that a taper in an end portion of a tube is the same as angularly disposing the end of the tube with respect to the body of the tube. However,  
15 Claim 4 has been amended to specifically state that the "tube is provided with an angular bend, adjacent the distal end of said tube, so that the open interior portion of said tube extends along a non-linear path between said proximal and distal ends." The hollow interior portion of the needle disclosed by Kater is linear from one end to its opposite end. Accordingly, claim 4 is believed to be allowable.

20 The Examiner rejected claim 8 under 35 U.S.C. § 102(b) as being anticipated by Kramer et al. (4,969,870). The applicant respectfully disagrees with the rejection. The Examiner states that Kramer et al. teach a device having a sleeve 19 that is slidably coupled to the outer surface of the tube 15. However, the figures within the Kramer  
25

reference clearly show that the tube 15 is attached in a fixed position within a handle 31,  
1 which is slidably disposed within the sleeve 19. Accordingly, the sleeve is not slidably  
coupled to the outer surface of the tube. If, for sake of argument the lower portion 43 of  
the handle 31 were deemed to be the "tube", the reference still wouldn't read on the  
claim due to the fixed engagement between the sleeve and the tube. Moreover, the  
5 distal end of the tube in that situation would not be capable of being positioned within  
the bone while the sealing surface was positioned outside the bone, as claimed within  
claim 8, due to positive stop within the base 19. Applicant has amended claim 8,  
however, to clarify the limitations previously set forth. The examiner is respectfully  
10 requested to reconsider the aforementioned rejection and allow claim 8.

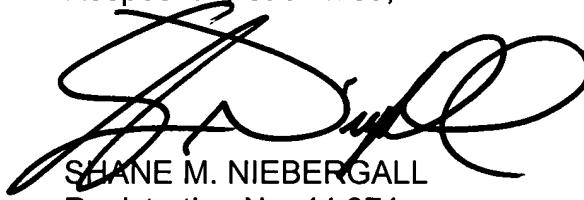
The Examiner has rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being  
unpatentable over the Kater reference in view of Lee et al. (5,693,030). The Examiner  
states that Kater fails to teach openings in the distal end of the tube or the use of an  
obturator but that the Lee reference teaches such structures. Similarly, the Examiner  
15 has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Kater in view  
of Dubinsky (WO 99/52441). Specifically, the Examiner states that Kater fails to teach a  
tube having an arcuate portion, as shown in Dubinsky. Claims 2, 3 and 5 depend from  
claim 1 and are believed to be allowable for at least the reasons set forth hereinabove  
20 with respect to claim 1. The combinations of claimed elements within claims 2, 3 and 5  
are believed to be patentable. Simple, combinable elements from the prior art do not  
necessarily render the claimed limitations obvious. In re Kotzab, 217 F.3d 1365, 55  
USPQ2d 1313 (Fed. Cir. 2000). More importantly, there is no teaching or suggestion  
25

that would render the claimed combination of elements "obvious". Ex parte  
1 Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Accordingly, the  
Examiner is respectfully requested to reconsider the aforementioned rejection and to  
allow claim 2, 3 and 5.

5 In light of the above amendments and remarks, applicant asserts that the claims  
are in condition for allowance. Applicant respectfully requests reconsideration and  
allowance of the same.

No fees or extensions of time are believed to be due in connection with this  
amendment; however, please consider this a request for any extension inadvertently  
10 omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,



15 SHANE M. NIEBERGALL  
Registration No. 44,974  
THOMTE, MAZOUR & NIEBERGALL  
Attorneys of Record

2120 South 72nd Street, Suite 1111  
Omaha, NE 68124  
(402) 392-2280

CERTIFICATE OF MAILING

20 I hereby certify that the original of this AMENDMENT AFTER FINAL REJECTION  
for R. MICHAEL GROSS, Serial No. 10/046,592, was mailed by first class mail, postage  
prepaid, to Mail Stop Amendments, Commissioner for Patents, P.O. Box 1450,  
Alexandria, VA 22313-1450, on this 24<sup>th</sup> day of May, 2005.

